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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,138	12/06/2005	Karl F. Johnson	019957-015920US	6771
20350 7590 10/31/2007 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER MEAH, MOHAMMAD Y	
			ART UNIT 1652	PAPER NUMBER
			MAIL DATE 10/31/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No. .

10/521,138

Applicant(s)

JOHNSON ET AL.

Examiner

Mohammad Meah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-44 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____                                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____   | 6) <input type="checkbox"/> Other: ____                           |

### **DETAILED ACTION**

The claims 1-44 are pending in the instant office action.

#### ***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 1, claims 1-8, drawn to a method production of fucosylated glycoprotein using fucosyltransferase comprising SEQ ID NO: 2.

Group 2, claims 1-8, drawn to a method production of fucosylated glycoprotein using fucosyltransferase comprising SEQ ID NO: 4.

Group 3, claims 1-8, drawn to a method production of fucosylated glycoprotein using fucosyltransferase comprising SEQ ID NO: 6.

Group 4, claims 1-8, drawn to a method production of fucosylated glycoprotein using fucosyltransferase comprising SEQ ID NO: 8.

Group 5, claims 9-23, drawn to a DNA comprising SEQ ID NO: 1 encoding fucosyltransferase, plasmid, vector and transformant containing said DNA and method of producing fucosyltransferase.

Group 6, claims 9-23, drawn to a DNA comprising SEQ ID NO: 3 encoding fucosyltransferase, plasmid, vector and transformant containing said DNA and method of producing fucosyltransferase.

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Group 7, claims 9-23, drawn to a DNA comprising SEQ ID NO: 5 encoding fucosyltransferase, plasmid, vector and transformant containing said DNA and method of producing fucosyltransferase.

Group 8, claims 9-23, drawn to a DNA comprising SEQ ID NO: 7 encoding fucosyltransferase, plasmid, vector and transformant containing said DNA and method of producing fucosyltransferase.

Group 9, claims 24-30, drawn to a fucosyltransferase comprising SEQ ID NO: 2.

Group 10, claims 24-30, drawn to fucosyltransferase comprising SEQ ID NO: 4.

Group 11, claims 24-30, drawn to fucosyltransferase comprising SEQ ID NO: 6.

Group 12, claims 24-30, drawn to fucosyltransferase comprising SEQ ID NO: 8.

Group 13, claims 31-43, drawn to a method production of fucosylated oligosaccharide using fucosyltransferase comprising SEQ ID NO: 2.

Group 14, claims 31-43, drawn to a method production of fucosylated oligosaccharide using fucosyltransferase comprising SEQ ID NO: 4.

Group 15, claims 31-43, drawn to a method production of fucosylated oligosaccharide using fucosyltransferase comprising SEQ ID NO: 6.

Group 16, claims 31-43, drawn to a method production of fucosylated oligosaccharide using fucosyltransferase comprising SEQ ID NO: 8.

The inventions listed in Groups 1-16 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The technical feature of Group 31 is the method steps using particular reagents. Said steps include making a product using protein of groups 9-12. However said product can be made with other method using different technical feature such as using chemical reagent. Groups 5-8 do not share same technical feature because they involve DNA of different structure. Groups 9-12 do not share same technical feature because they involve protein of different structures. The technical feature of Groups 1-4 and 13-16 is the method steps using particular reagent having different technical feature and produce different substance having different technical features.

Furthermore, the technical feature linking group 1-16 appears to be that they all relate to fucosyltransferase comprising SEQ IDs 12, 4, 6, 8 which does not constitute a "special technical feature" as defined by PCT Rule 13.2, because it does not claim a feature which defines a contribution over the prior art as fucosyltransferase comprising SEQ IDs 12, 4, 6, 8 are taught thorough US Patent 6399377.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in

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the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad Meah whose telephone number is 571-272-1261. The examiner can normally be reached on 8:30-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 571-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



Mohammad Younus Meah, PhD

Examiner, Art Unit 1652

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